



PTO/SB/21 (09-04)

Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**TRANSMITTAL
FORM**

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

18

Application Number

10/800,580

Filing Date

03/15/2004

First Named Inventor

Kenji Inoue

Art Unit

1771

Examiner Name

E. Cole

Attorney Docket Number

KIN99USA

ENCLOSURES (Check all that apply)

Fee Transmittal Form



Fee Attached



Amendment/Reply



After Final



Affidavits/declaration(s)



Extension of Time Request



Express Abandonment Request



Information Disclosure Statement



Certified Copy of Priority Document(s)

Reply to Missing Parts/
Incomplete ApplicationReply to Missing Parts
under 37 CFR 1.52 or 1.53

Drawing(s)



Licensing-related Papers



Petition

Petition to Convert to a
Provisional Application

Power of Attorney, Revocation



Change of Correspondence Address



Terminal Disclaimer



Request for Refund



CD, Number of CD(s) _____

☐ Landscape Table on CD

After Allowance Communication to TC

Appeal Communication to Board
of Appeals and InterferencesAppeal Communication to TC
(Appeal Notice, Brief, Reply Brief)

Proprietary Information



Status Letter

Other Enclosure(s) (please identify
below):

Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name

Howson and Howson

Signature

Printed name

George A. Smith, Jr.

Date

07/27/2006

Reg. No.

24,442

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature

Typed or printed name

George A. Smith, Jr.

Date

07/27/2006

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



Under the Paperwork Reduction Act of 1995 no persons are required to respond to a collection of information unless it displays a valid OMB control number

Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL
For FY 2006☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 500.00

Complete if Known

Application Number 10/800,580

Filing Date 03/15/2004

First Named Inventor Kenjii Inoue

Examiner Name E. Cole

Art Unit 1771

Attorney Docket No. KIN99USA

METHOD OF PAYMENT (check all that apply)☒ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): _____☒ Deposit Account Deposit Account Number: 08-3040 Deposit Account Name: Howson and Howson

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☐ Charge fee(s) indicated below☐ Charge fee(s) indicated below, except for the filing fee☒ Charge any additional fee(s) or underpayments of fee(s)
under 37 CFR 1.16 and 1.17☒ Credit any overpayments**WARNING:** Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**FEE CALCULATION** (All the fees below are due upon filing or may be subject to a surcharge.)**1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES**Fee Description**

Each claim over 20 (including Reissues)

Fee (\$)
50Small Entity Fee (\$)
25

Each independent claim over 3 (including Reissues)

200

100

Multiple dependent claims

360

180

Total Claims **Extra Claims** **Fee (\$)** **Fee Paid (\$)****Multiple Dependent Claims**

- 20 or HP = _____ x _____ = _____

Fee (\$) **Fee Paid (\$)**

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims **Extra Claims** **Fee (\$)** **Fee Paid (\$)**

- 3 or HP = _____ x _____ = _____

HP = highest number of independent claims paid for, if greater than 3.

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets **Extra Sheets** **Number of each additional 50 or fraction thereof** **Fee (\$)** **Fee Paid (\$)**

- 100 = _____ / 50 = _____ (round up to a whole number) x _____ = _____

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Fees Paid (\$)

Other (e.g., late filing surcharge): Brief on Appeal

\$500.00

SUBMITTED BY

Signature

Registration No.
(Attorney/Agent) 24,442

Telephone 215-540-9200

Name (Print/Type) George A. Smith, Jr.

Date 07/27/2006

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application No.: 10/800580
Applicant: Kenji Inoue
Filed: 03/15/2004
TC/A.U.: 1771
Examiner: E. Cole
Docket No.: KIN99USA
Customer No. 00270

Confirmation No: 1657

BRIEF ON APPEAL

MAIL STOP Appeal Brief - Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING
UNDER 37 C.F.R. §1.8(a)(1)(ii)
(PATENT)

I certify that this paper is being deposited on the date shown below with the United States Postal Service, with sufficient postage, as first class mail and is addressed to "Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450."

Signed
Date:

George A. Smith
July 27, 2006

Sir:

This appeal is from the final rejection in the Office Action dated March 7, 2006.

A check for the fee of \$500.00 for filing this Appeal Brief is attached. The Commissioner is hereby requested to charge any deficiency in the fee due with the filing of this paper, or credit any overpayment, to our Deposit Account, No. 08-3040.

The Notice of Appeal was filed June 5, 2006. This brief is therefore timely. However, please grant an extension of time if necessary, and charge any extension fee to the above-mentioned deposit account.

Serial No. 10/800580
Filed 03/15/2004
Brief on Appeal

I. REAL PARTY IN INTEREST

The real party in interest is the inventor's assignee, Ichikawa Co., Ltd., a Japanese corporation, located at 14-15, Hongo 2-chome, Bunkyo-ku, Tokyo, Japan.

II. RELATED APPEALS AND INTERFERENCES

None.

III. STATUS OF CLAIMS

The pending claims are claims 1 and 2. The version appearing in the Claims Appendix assumes that the amendment under 37 C.F.R. §1.116, mentioned in the next section, has been entered.

IV. STATUS OF AMENDMENTS

An amendment under 37 C.F.R. § 41.33(a) was filed after the filing of the notice of appeal, but before the filing of this brief. The amendment is intended to obviate the rejection under 35 U.S.C. §112. The examiner has not yet been acted upon the amendment.

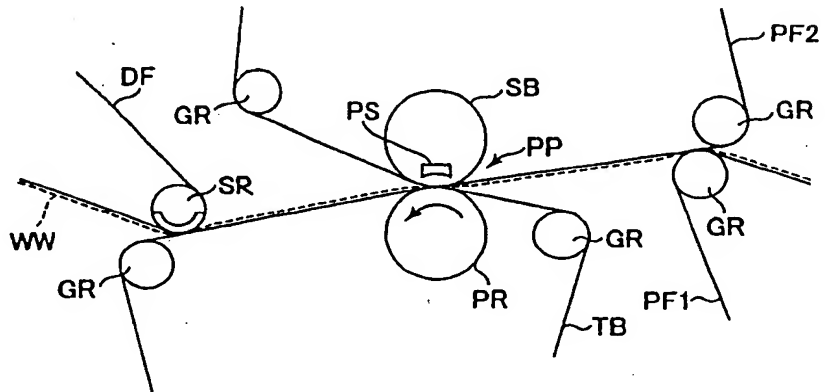
V. SUMMARY OF CLAIMED SUBJECTION MATTER

In a papermaking machine, as depicted in FIG. 9, reproduced below, a wet paper web WW, represented by a broken line, is typically moved through a part of the machine known as a "press

part" (PP), which consists of a press roll PR, a fixed press shoe PS opposed to the press roll, and a shoe press belt SB, that travels around the shoe, between the shoe and the press roll.

FIG. 9

PRIOR ART



The wet paper web WW is first carried on a press felt PF1, transferred to a second press felt PF2, and carried by press felt PF2 into the press part PP,¹ where water is squeezed out of the wet paper web WW and taken up by the press felt PF2. In the press part, the wet paper web WW is transferred to a transfer belt TB, which carries the wet paper web away from the press part. In a subsequent stage, the wet paper web is taken off the transfer belt and transferred to a dryer fabric DF by a suction roll SR.²

A transfer belt has two conflicting requirements. It is important for the wet paper web to be attached to the surface of the transfer belt immediately after the wet paper web moves out of the

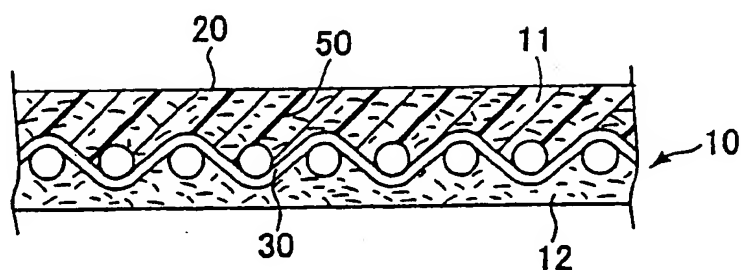
¹Specification, paragraph 0004, page 2, lines 5-6.

²Specification, paragraph 0007, page 2, lines 27-31.

press part.³ On the other hand, release of the wet paper web from the transfer belt at the suction roll is also important.⁴ The invention is a transfer belt that has been found to exhibit superior performance in achieving both of these objectives. As demonstrated by the test results appearing in the table at page 14 of the Applicant's specification, compared to the prior art, the invention is capable of achieving good attachment and good transfer over a wider range of dryness of the paper web as it exits the press part.

As shown in FIG. 1, the transfer belt 10 comprises a base body 30, a wet paper web side layer 11, which is contacted by the wet paper web WW, and a machine side layer, which is contacted by the press roll PR.⁵

FIG. 1



³Specification, paragraph 0010, page 3, lines 19-22.

⁴Specification, paragraph 0008, page 3, lines 1-5.

⁵Specification, paragraph 0024, page 5, line 30 - page 6, line 2.

The machine side layer 12 comprises a batt layer composed of staple fibers. These fibers are intertwined with the machine side of the base body 30.⁶

The base body 30 is typically a woven fabric.⁷ The wet paper web side layer 11 is formed from an elastic section 50 and a fiber body 20.⁸ Part of the fiber body 20 is exposed on the surface of the elastic section 50, that is, fibers appear on the surface of the elastic section 50, but may or may not protrude from the surface.⁹

At least the parts of the fiber body exposed at the surface of the elastic section 50 are hydrophilic, meaning that they attract and/or hold, water. For example, a hygroscopic fiber is hydrophilic because moisture absorption by the fiber causes the fiber to have an affinity for water.¹⁰

The fiber body 20 can be composed of materials such as nylon, rayon, cotton or wool¹¹, which are inherently hydrophilic, or may be made hydrophilic by a treatment such as Mercerization, resin treatment, sputtering by ionizing radiation or glow discharge processing.¹² Only the exposed portions of the fiber body 20 need to

⁶Specification, paragraph 0033, page 8, lines 19-22.

⁷Specification, paragraph 0044, page 11, line 30.

⁸Specification, paragraph 0024, page 6, lines 2-4.

⁹Specification, paragraph 0024, page 6, lines 5-12.

¹⁰Specification, paragraph 0025, page 6, lines 13-20.

¹¹Specification, paragraph 0027, page 6, lines 27-30.

¹²Specification, paragraph 0027, page 7, lines 7-11.

be hydrophilic, but in practice the entire fiber body 20 will ordinarily be hydrophilic.¹³

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

(a) Rejection under 35 U.S.C. §112.

The claims were rejected as indefinite because of the term "high molecular weight," used to qualify the "elastic section." This rejection will have been obviated if the amendment recently filed under 37 C.F.R. § 41.33(a) is entered.

(b) Rejection under 35 U.S.C. §103.

Both of claims 1 and 2 were rejected as unpatentable over JP 2001-89990 (JP' 990) in view of published U.S. patent application 2002/0060057 (Westerkamp). JP '990 describes a transfer belt in which the wet paper web side layer comprises an elastic section 2 and a fiber body 3, and either the elastic section or the fiber body comprises a hydrophobic material which functions to break the thin water film formed between the wet paper web and the transfer belt after the transfer belt carrying the web moves out of the press part of the papermaking machine. Westerkamp describes a papermaking belt in which the surface can be made to have hydrophilic, hydrophobic, anti-static, or stain-releasing properties by appropriate physical or chemical surface treatments (Westerkamp, paragraph 0029).

¹³Specification, paragraph 0027, page 6 line 32- page 7, line 6.

According to the rejection, it would have been obvious to one of ordinary skill in the art to have applied a hydrophilic coating to the surface of the belt of JP'990, as taught by Westerkamp.

VII. ARGUMENT

(a) Rejection under 35 U.S.C. §112

The amendment recently filed eliminates the term "high molecular weight," which had previously qualified the term "elastic section" in claim 1. The language "high molecular weight" is in common use in the field of papermaking belt manufacture, and appears in the claims of numerous patents, including for example, 6,440,274, 6,331,231, and 6,325,897. If the amendment is entered, the definiteness of the term "high molecular weight" is no longer an issue.

(b) Rejection JP2001-89990 in view of Westerkamp

Westerkamp's paragraph 0029 in no way suggests that the physical or chemical surface treatment is applied only to a part of the surface 21 of fiber layer 20. Thus, paragraph 0029 would not be understood as teaching anything other than that a hydrophilic, hydrophobic, anti-static or stain-releasing character is imparted to the entire surface of the fiber layer. Moreover, as seen in Westerkamp's drawings, surface 21 is continuous. Finally, as mentioned in Westerkamp's paragraph 0029, the surface charge potentials of the fiber layer 20 are to be "harmonized" with those

of the fiber suspension to be dewatered. Thus, there is no suggestion that the surface treatment can or should be applied in such a way that the surface is other than uniform insofar as its hydrophilic or hydrophobic character is concerned.

At issue in this case is the proper interpretation of JP '990. Does it teach that the surface of the belt can be uniformly hydrophobic, or is it essential that only part of the surface be hydrophobic?

Briefly, the Applicant's position is that non-uniformity is an essential feature of JP '990; either the fibers 3 or the elastic material 2, but not both, are hydrophobic. Westerkamp's approach is to treat a surface so that its properties are uniform, that is, that the surface is uniformly hydrophobic, or uniformly hydrophilic. The approaches in JP '990 and Westerkamp are antithetical, and therefore there is no basis for combining the teachings of the two references.

According to the Examiner, JP '990 teaches that both elements, the fabric 3 and the elastic material 2, can be hydrophobic and that the entire surface can be hydrophobic.¹⁴ The Examiner reasons that since JP '990 does not teach a non-uniform surface material, "to combine the teachings of Westerkamp to JP '990 would not destroy the material of JP '990." In other words, the Examiner considers the teachings of Westerkamp to be applicable to the belt of JP '990.

The Applicant does not agree with the assertion that JP '990 does not teach a non-uniform surface material. On the contrary, non-uniformity is an essential feature in JP '990. The English

¹⁴Paragraph 7 of final Office action

translation of JP '990, which was supplied by the PTO, is not particularly clear, and one is tempted by some of the language in the translation to conclude that uniform hydrophobicity is an option. However, we submit that the correct interpretation is that, in all cases, only a part of the surface in JP '990 is hydrophobic.

Paragraphs 0018-0020 of the translation are the pertinent paragraphs, and read as follows:

"[0018] Either said wet paper web installation side 2b or surface outcrop 3' is formed for a hydrophobic material, and the part which keeps away water, and the part which condenses water are prepared in the shape of distribution, and it constitutes so that the water screen may not be made between a wet paper web and a wet paper web installation side. The surface free energy of this hydrophobic wet paper web installation side 2b or surface outcrop 3' is desirable at the point that the force in which the following [30 dyn/cm (erg/cm²)] keep away water becomes strong.

"[0019] In order to make said surface outcrop 3' into hydrophobicity, the whole surface organizer 3 may be formed for a hydrophobic material. Although fluorine fiber is mentioned as a hydrophobic material, even if it processes other fiber with silicon or fluorine water repellent and it gives hydrophobicity, hydrophobicity may be given by the approach of making hydrophobic oil, such as silicon powder and a silicone oil, mixing in fiber.

"[0020] Moreover, in order to make said wet paper web installation side 2b into hydrophobicity, the whole macromolecule elastic member 2 may be formed for a hydrophobic material. There are a fluororesin, silicon resin, etc. as a hydrophobic material. Before the material of the macromolecule elastic member 2 hardens also in this case (while holding a fluidity), hydrophobicity may be given by mixing fluorine oil,

a silicone oil, fluorine powder and silicon powder. In addition, the ratio of the hydrophobic part to the surface area of a wet paper web installation side is 10 - 90%, and is suitably changed according to the class of paper to manufacture."

The Examiner has cited paragraphs 0019 and 0020 as teaching "that both elements [3 and 2b] can be hydrophobic and that the entire surface can be hydrophobic." This conclusion is not supportable for several reasons.

First, insofar as element 3 is concerned, this element is referred to as a "surface organizer." While it is not clear what "surface organizer" means, the reference number 3 appears twice in Figures 1 and 2 of JP '990, and in each case the lead line points to an embedded fiber. Thus, the language in paragraph 0019 that states that "the whole surface organizer 3 may be formed for (of?) a hydrophobic material," apparently means only that the embedded fibers are hydrophobic, not that the entire surface is hydrophobic.

Second although paragraph 0020 uses the language "in order to make the wet paper web installation side 2b into hydrophobicity," it goes on to say explicitly that the "ratio of the hydrophobic part to the surface area of a wet paper web installation side is 10-90%," clearly indicating that the surface is never entirely hydrophobic. Moreover, paragraph 18 distinguishes the wet paper web installation side 2b from surface outcrop 3', and thus the area of the installation side 2b is the area of the elastic material only, which is the total area of the web-contacting side excluding the area of the outcrops.

Third, although the Examiner has stated that JP '990 teaches that both elements can be hydrophobic, this statement does not tell the whole story. Indeed each of the elements can be hydrophobic. However, nowhere does JP '990 say that both elements can be hydrophobic at the same time. The entire thrust of JP '990, and especially the opening sentence of paragraph 0018, are to the contrary.

In summary, therefore, JP '990 does not teach that the surface of the belt can be uniformly hydrophobic. Rather, it is essential that only part of the surface be hydrophobic. There is nothing in JP '990 or Westerkamp that would motivate one skilled in the art to apply the teachings of Westerkamp, specifically Westerkamp's hydrophilic treatment, to the product of JP '990.

The Applicant's invention is characterized by a wet paper web side layer comprising an elastic section and a fiber body, at least a part of which is exposed and hydrophilic. Neither JP '990 nor Westerkamp teaches this, and there is no basis for combining the two references. It follows that the rejection under §103 should be reversed.

(c) No separate argument for claim 2

No separate argument is being presented in support of dependent claim 2.

(d) JP '990 does not anticipate claim 1

The Examiner has not asserted that claim 1 is anticipated by JP '990, but has instead applied an obviousness rejection under §103

based on two references. Nevertheless, since the question may arise as to whether or not the claimed invention is patentable over JP '990 considered by itself, it should be observed that JP '990 does not relate to hydrophilicity at all. In the automated translation, at page 3, lines 6 and 7, reference is made to a "side of hydrophobicity" and to a "side of non-hydrophobicity." However, non-hydrophobicity is not the same thing as hydrophilicity. In JP '990, so long as the surface has hydrophobic areas, water will be repelled from these hydrophobic areas and condense in other areas on the surface of the belt. It is unnecessary that the other areas be hydrophilic, and nothing in JP '990 implies that there are hydrophilic areas.

The U.S. patent that corresponds to JP '990 is Patent 6,319,365. There, the term "side of non-hydrophobicity" was translated as "hydrophilic side," at col. 3, line 13, and again at column 12, line 26. This is a mistranslation of the Japanese text. Moreover, nowhere in Patent 6,319,365 is there an explanation of why a portion of the belt should have a hydrophilic character. A person skilled in the art, reading the U.S. patent, would realize that hydrophilicity is unnecessary to the proper operation of the belt in Patent 6,319,365, and would recognize that the term "hydrophilic" was used loosely as a convenient way to say "non-hydrophobic." A person reading Patent 6,319,365 with the level of understanding of one skilled in the art of papermaking belt design would not infer that the term signifies a property by which a fiber body attracts and/or holds water, which is the definition of "hydrophilic" and

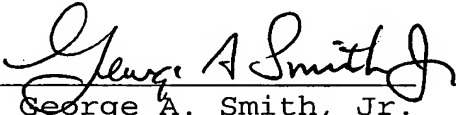
Serial No. 10/800580
Filed 03/15/2004
Brief on Appeal

"hydrophilicity" set forth in paragraph 0025 of the Applicant's specification.

(e) Conclusion

If the amendment under 37 C.F.R. § 41.33(a) is not entered, the section 112 rejection should be reversed for the reasons stated in part VII (a). The two references cited in support of the rejection under section 103 are not properly combinable, and this rejection should also be reversed.

Respectfully submitted,
HOWSON & HOWSON

By 
George A. Smith, Jr.
Reg. No. 24,442
Howson & Howson
Box 457
Spring House, PA 19477
Telephone: 215 540 9200
Facsimile: 215 540 5818

Enclosure:
(a) appeal fee

Serial No. 10/800580
Filed 03/15/2004
Brief on Appeal

VIII. CLAIMS APPENDIX

1. A wet paper transfer belt for use in the press part of a closed draw papermaking machine, comprising a base body, a wet paper web side layer having a wet paper web side surface, and a machine side layer, wherein said wet paper web side layer comprises an elastic section and a fiber body, at least a part of the fiber body is exposed on said wet paper web side surface, and at least the exposed part of the fiber body is hydrophilic.

2. A wet paper web transfer belt as claimed in claim 1, wherein hydrophilic treatment is applied to the surface of the exposed part of the fiber body.

3-4 (cancelled).

Serial No. 10/800580
Filed 03/15/2004
Brief on Appeal

IX. EVIDENCE APPENDIX

None

Serial No. 10/800580
Filed 03/15/2004
Brief on Appeal

X. RELATED PROCEEDINGS APPENDIX

None